

**Remarks**

**Allowed Subject Matter**

In the Office Action dated February 21, 2006 the Examiner indicated that Claims 27-32 were allowed. Applicants graciously acknowledge the Examiner's determination.

**The Rejection of Claims 1-3, 5-7 and 9-26 under 35 USC § 103 (a)**

Claims 1-3, 5-7 and 9-26 were rejected under 35 USC §103(a) as unpatentable over U.S. Patent Application No. 2004/0246571 (*Bonaventura*). Applicants respectfully traverse the rejection and request reconsideration for the following reasons.

This ground of rejection cannot stand because *Bonaventura*, and the captioned subject invention are **commonly owned**. *Bonaventura* and the instant application are both assigned to Leica Microsystems GmbH, and thus are **commonly owned**.

Under the present circumstances the rule that should apply is cited as: ¶ 7.21.02 *Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*, appearing on Page 700-65 of the MPEP, cited below:

¶ 7.21.02 *Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*

“Claim [1] rejected under 35 U.S.C. 103(a) as being obvious over [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration

under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). *This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). [4]*” MPEP § 706.02(m) (emphasis added).

#### **Statement of Common Ownership**

**Application Serial No. 10/811,346 (the present application) and U.S. Patent Application No. 2004/0246571 (Bonaventura) were, at the time the invention of Application Serial No. 10/811,346 was made, owned by, or subject to an obligation of assignment to Leica Microsystems GmbH. Leica Microsystems, Inc. and Leica Microsystems Wetzlar GmbH are both wholly owned subsidiaries of Leica Microsystems GmbH.**

Effective November 29, 1999, subject matter which was prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e) is **now disqualified as prior art** against the claimed invention because the subject matter of the *Bonaventura* patent and the claimed invention were, at the time the invention was made, owned by the same person, namely Leica Microsystems GmbH.

Accordingly, the basis for the rejection of the claims for reasons of obviousness that includes the citation of *Bonaventura* cannot stand because this citation has been effectively removed as a reference.

As stated in the Statement of Common Ownership above, Bonaventura and the invention of the present application were commonly owned by Leica Microsystems at the time the invention in Claims 1-3, 5-7 and 9-26 of the present application was made. Under § 103(c), Bonaventura cannot be cited as qualifying prior art against Claims 1-3, 5-7 and 9-26 in light of the common ownership of Bonaventura and the present claimed invention. Because Bonaventura is cited against Claims 1-3, 5-7 and 9-26, the current rejection of Claims 1-3, 5-7 and 9-26 under § 103(a) should be withdrawn and those claims passed to allowance. Applicants

respectfully request withdrawal of the rejections of Claims 1-3, 5-7 and 9-26 and passage to allowance of those claims.

Assuming *arguendo* that *Bonaventura* could be used to support a rejection under 35 U.S.C. § 103, which it can not, the rejection fails for the following reasons.

### **Claims 1 and 5**

*Bonaventura* does not teach, suggest, or motivate the following elements of Claim 1 and 5: 1) a removable interchangeable focus adjustment knob; 2) focus adjustment means; and, 3) magnetically fastening these two elements together. Magnetic tool 12 is described in paragraph [0022] of *Bonaventura* as a tool to align the objectives of a microscope. One of ordinary skill in the art would not consider alignment of objectives to be the same as adjusting the focus of a microscope, which is what the removable interchangeable focus adjustment knobs recited in Claims 1 and 5 do when they are magnetically fastened to the focus adjustment means. Applicants respectfully submit that in paragraph [0023] of *Bonaventura*, there is no reference to a removable interchangeable focus adjustment knob connected to a focus adjustment means, and thus, there is no reference to those two components being magnetically fastenable to each other. Hence, since elements of Claims 1 and 5 are not taught or suggested by *Bonaventura*, a *prima facie* case of obviousness has not been established for Claims 1 and 5.

Therefore, Claims 1 and 5, and all claims dependent therefrom, are patentable over *Bonaventura*.

### **Claim 12**

Claim 12 recites a focus adjustment means comprising a focus adjustment knob and a removable focus adjustment knob that are coaxial and independently rotatable with respect to each other. *Bonaventura* fails to teach, suggest, or motivate the preceding elements of Claim 12. Contrarily, *Bonaventura* discloses microscope tool 12 for aligning objectives comprising handle 26 fixedly attached to tip 18. It is impossible for the tip and the handle to rotate independently as they are fixedly attached. Since microscope tool 12, disclosed in *Bonaventura*, comprises one

piece, *i.e.*, handle **26** fixedly secured to tip **18**, *Bonaventura* does not disclose a device having two independent parts, *i.e.*, a focus adjustment knob and a removable focus adjustment knob that can be rotated independently.

Consequently, all the elements of Claim 12 are not taught or suggested by *Bonaventura*, and thus a *prima facie* case of obviousness has not been established for Claim 12.

Therefore, Claim 12 and all claims dependant therefrom are patentable over *Bonaventura*.

### **Claim 22**

Neither paragraph [0022] or [0023] of *Bonaventura* contain a teaching or suggestion of a focus drive means or a removable focus adjustment knob as recited in Claim 22. As described *supra*, *Bonaventura* discloses microscope tool **12** with adjusting tip **18** and handle **24**. It is explicitly stated that tool **12** is used to **align** the objectives of a microscope (paragraph [0022]). Alignment is defined as centering on the same axis, while focus is defined as adjusting a lens to make the image appear sharp and well defined. The claimed interchangeable focus adjustment knob of the subject application is not for **aligning** the objectives, but it is for **focusing** the objectives. Thus, there are significant structural and functional differences between tool **12** and the focus adjustment knob. Since elements of Claim 22 are not taught or suggested by *Bonaventura*, a *prima facie* case of obviousness has not been established for Claim 22.

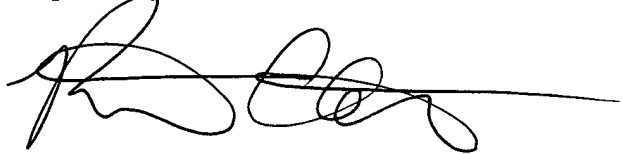
Therefore, Claim 22 and all claims dependant therefrom are patentable over *Bonaventura*.

Attorney Docket No. LEAP:128US  
U.S. Patent Application No. 10/811,346  
Reply to Office Action of February 21, 2006  
Date: April 21, 2006

**Conclusion**

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned agent of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert C. Atkinson', with a long horizontal line extending to the right.

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Dated: April 21, 2006